

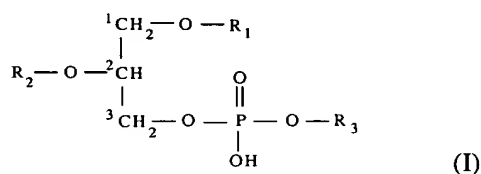
### REMARKS

Claims 1-4 and 6-25 stand rejected and are pending in the present application. No new matter has been added.

### Invention Synopsis

The present invention relates to cosmetic compositions having improved application benefits to keratinous tissue and keratinous fibers wherein said compositions have improved application benefits, while avoiding the negatives associated with compositions currently known in the art. The compositions of the present invention can comprise the following components either before or after mixing:

- a. from about 0.1% to about 5% of a phospholipid having the formula



in which  $\text{R}_1$  represent  $\text{C}_{10-20}$  acyl,  $\text{R}_2$  represent hydrogen or  $\text{C}_{10-20}$  acyl,  $\text{R}_3$  represent hydrogen, 2-trimethylamino-1-ethyl, 2-amino-1-ethyl,  $\text{C}_{1-4}$  alkyl,  $\text{C}_{1-5}$  alkyl substituted by carboxy,  $\text{C}_{2-5}$  alkyl substituted by hydroxy,  $\text{C}_{2-5}$  alkyl substituted by carboxy and hydroxy or  $\text{C}_{2-5}$  alkyl substituted by carboxy and amino, the inositol group or the glyceryl group, or salts of these compounds;

- b. from about 0.1% to about 30%, by weight of the composition, of a PVP copolymer selected from the group consisting of tricontanyl PVP copolymer, PVP/hexadecane copolymer, and mixtures thereof; and
- c. from about 0.1% to about 30%, by weight of the composition, of at least one resin.

### FORMAL MATTERS

#### REJECTIONS UNDER 35 USC §103

Claims 1-4 and 6-25 have been rejected under 35 USC §103(a) as being unpatentable over Bartholomey et al., US 5614200 (hereinafter "Bartholomey") in view of Snyder et al., US 5389363 (hereinafter "Snyder"). The Office states that Bartholomey teaches mascara compositions comprising lecithin (Phospholipon 80), which meets the limitations of instant claim 1(a) and 2-4; and ammonia acrylate copolymer (Syntran 5170) which meets the limitations of

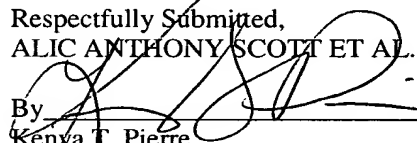
instant claims 1(c) and 6-8. Additionally, the Office states that adding film-forming agents such as PVP and PVP/VA copolymers is suggested by the disclosure. Further, the Office states that example formulas in Bartholomey teaches to use waxes, glyceryl monostearate, water/ethanol solvents, black iron oxide, triglyceride, and preservatives and believes the weight ratio of glycerol monostearate to lecithin as required by instant claims 10-11 are also disclosed. Although the Office concedes that Bartholomey fails to teach the specific type of PVP copolymers in instant claim 1(b), the Office has determined that Snyder teaches a waterproof mascara formulation comprising 1.5% of PVP tricontanyl copolymer. Therefore, the Office reasons that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have looked to the prior art such as Snyder for specific types of the film-forming copolymers based on the general teaching of Bartholomey. Alternatively, the Office states that the skilled artisan would have been motivated to modify the Bartholomey invention by adding PVP tricontanyl copolymer as suggested by Snyder because of the expectation of successfully producing waterproof mascara. Applicants respectfully traverse.

Bartholomey discloses a composition which comprises from about 20% to about 65% solids; from about 20% to about 80% liquid vehicle; and from about 8% to about 50% a setting rate which delays the setting of the composition long enough to provide sufficient time to distribute the mascara in semi-liquid form onto the lashes as well as contribute to lash-thickening properties while avoiding negative aesthetics. Snyder discloses a cosmetic composition for lengthening, curling, and coloring human eyelashes comprising 10-25% of a gel composition and 75-90% of an oil in water emulsion base composition wherein when the gel composition is mixed into the base composition the water dissipatable polymer of the gel composition reacts with the oil soluble synthetic polymer of the base composition. The references, however, fail to teach or suggest each and every limitation of Applicants' claimed cosmetic composition that provides lash thickening, separation, and detangling in combination with long wear. Although Bartholomey generally discloses a PVP copolymer as an optional ingredient, it fails to teach the necessity of the claimed amount of Applicants' specific PVP copolymers in combination with Applicants' claimed range of lecithin and resin that provides the benefits of aesthetic improvements and longevity. The combination provided by Bartholomey fails to teach or suggest the particular formulation and particular ratios that chemically provides the aesthetic attributes of the presently claimed invention, particularly the ability to detangle and separate lashes without sacrificing wear and lash thickening. Instead, Bartholomey discloses mascara compositions having improved *application characteristics* whereby the setting rate agent allows the mascara to remain in semi-liquid form in order to provide sufficient time for one to distribute the mascara onto the lashes

thereby contributing to lash-thickening properties and clump reduction. Therefore, the Bartholomey consumer must mechanically contribute to the aesthetics that may still fall short of Applicants' presently claimed invention. Since the attributes of Bartholomey can be achieved by relying on the setting rate agent, there would be no motivation to combine the disclosure of Snyder to modify Bartholomey as suggested by the Office. Additionally, Snyder discloses the reaction of two film forming polymers in order to provide lengthening properties. Such formulation may provide lengthening but would fall short of the other aesthetics, such as lash separation, taught by Applicants presently claimed invention. There is no teaching or suggestion of adding Applicants PVP copolymer or lecithin in order to arrive at the aesthetically-pleasing formulation of Applicants invention. Applicants respectfully submit that it is well settled that the Examiner cannot pick and choose among individual elements of assorted prior art references to recreate the claimed invention based on the hindsight of Applicants' invention. Rather, the Examiner has the burden to show some teaching or suggestion in the references to support their use in the particular claimed combination. *See, SmithKline Diagnostics, Inc. v. Helena Laboratories Corp.*, 8 USPQ2d 1468, 1475 (Fed. Cir. 1985). Additionally, the mere fact that it is possible to find isolated disclosures which might be combined in such a way as to produce a new composition does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination. *In re Grabiak*, 222 USPQ2d 870, 872 (Fed. Cir. 1985). Since there is no desire or motivation to combine Bartholomey and Snyder, the cosmetic composition of the present invention cannot be rendered as obvious. In light of the foregoing, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 USC §103(a).

#### CONCLUSION

In view of the above, Applicants respectfully submit that each of the issues raised by the Office has been addressed. Reconsideration and allowance of each of the pending claims is therefore respectfully requested.

Respectfully Submitted,  
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